

No. 20510 ✓

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

AEROTEC INDUSTRIES OF CALIFORNIA, *et al.*,

Appellants,

vs.

PACIFIC SCIENTIFIC COMPANY,

Appellee.

APPELLEE'S PETITION FOR A REHEARING.

C. RUSSELL HALE,

D. BRUCE PROUT,

201 South Lake Avenue,
Pasadena, Calif. 91101,

Attorneys for Appellee.

FILED

AUG 25 1957

WM. B. LUCK, CLERK

SEP 20 1957



TOPICAL INDEX

Page

I.

The Decision Conflicts With a Long Line of Authorities Because It Finds That the Invention Is Anticipated, Based on an Interpretation of the Invention Which Is of Broader Scope Than the Claims of the Patents	1
---	---

II.

The Decision Conflicts With a Long Line of Authorities Because It Finds Two Arts Analogous Even Though the Arts Are in Completely Different Fields and for Completely Different Purposes	3
--	---

III.

The Decision Conflicts With a Long Line of Authorities That Have Construed the Statutory Test for Obviousness Because It Employs a Hind-sight Test, Rather Than Looking at What Was Known at the Time the Inventions Were Made ..	4
---	---

TABLE OF AUTHORITIES CITED

Cases	Page
A. J. Deer Co. v. U.S. Slicing Mach. Co., 21 F. 2d 812	4
American Technical Machine Corp. v. Caparotta, 339 F. 2d 557	5
Bennett, In re, 65 F. 2d 144	4
Dominion Magnesium Limited v. United States, 320 F. 2d 388	1
Graham v. John Deere Co., 383 U.S. 1	5
Hobbs v. Beach, 180 U.S. 383	4
Hofstetter, Application of, 362 F. 2d 293	5
Kaakinen v. Peelers Company, 301 F. 2d 170	4
Keating v. Stearnes Imperial Co., 347 F. 2d 444	1
Krogman, Application of, 223 F. 2d 497	3
McClain v. Ortmyer, 141 U.S. 419	1
Oregon Saw v. McCulloch, 323 F. 2d 7581,	2
Potts v. Creager, 155 U.S. 597	3
Skinner Co. v. Continental Industries, 346 F. 2d 170	5
Stauffer v. Slenderella, 254 F. 2d 127	2
Stearns v. Tinker & Rasor, 220 F. 2d 49	4
United States v. Adams, 383 U.S. 391,	2
Van Wanderham et al., In re, 154 USPQ 203, 4,	5
Statute	
United States Code, Title 35, Sec. 103	3

No. 20510

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

AEROTEC INDUSTRIES OF CALIFORNIA, *et al.*,

Appellants,

vs.

PACIFIC SCIENTIFIC COMPANY,

Appellee.

APPELLEE'S PETITION FOR A REHEARING.

Appellee respectfully requests the Court to grant a rehearing because the decision does not conform to long lines of authorities in three respects.

I.

The Decision Conflicts With a Long Line of Authorities Because It Finds That the Invention Is Anticipated, Based on an Interpretation of the Invention Which Is of Broader Scope Than the Claims of the Patents.

The decision states (p. 12) if the trolley catcher reels had been designed later than the inventions in suit, the claims in suit would read directly on the trolley catchers. Hence, the trolley catchers anticipate.

This gives the claims a court-imposed scope which is broader than the express language of the claims, broader than the patentee asserted before the Patent Office and the District Court, and broader than the express findings of the District Court. It is impossible to read the express language of claim 7 of Pfankuch, for example, on any trolley catcher. "But the Courts have no right to enlarge a patent beyond the scope of its claim" *McClain v. Ortmyer* 141 U.S. 419 (1891). *United States v. Adams* 383 U.S. 39 (1966). *Keating v. Stearnes Imperial Co.* 347 F. 2d 444 (7th Cir. 1965). *Oregon Saw v. McCulloch* 323 F. 2d 758 (9th Cir. 1963).

Even if the claims were susceptible of several constructions, they should be interpreted to preserve to the patentee his actual invention and so as to avoid anticipation. *McClain v. Ortmyer*, *supra*. *Dominion Magnesium Limited v. United States* 320 F. 2d 388, 398 (Ct. Cl. 1963).

The actual invention is apparatus for saving lives. Abstractions have been introduced, such as protecting dummies or cargo. One of the patents (Pfankuch)

vaguely mentions use of the devices in freight handling, without further explanation. Such far-fetched abstractions should not obscure matters of substance. Such abstractions are not claimed. "Specifications can be used to limit the claims, but not to expand them". *Oregon Saw v. McCulloch, supra.*

The holding of anticipation is directly contrary to a long line of authorities, including a different panel of this Court, which say that for the technical defense of anticipation, a single piece of prior art must bear within its four corners all of the elements in exactly the same situation and united in the same way to perform the identical function. *United States v. Adams, supra.* *Stauffer v. Slenderella* 254 F. 2d 127 (9th Cir, 1957).

Finding 24 by the District Court states that the four claims in suit define arrangements for preventing a seat occupant from being thrown from his seat, having an inertia locking device mounted on the back of the seat, and means responsive to abnormal movement of the seat occupant for locking the device. The decision here (p. 4) points out that it is the inertial force of the body to which the apparatus is coupled that is used to activate the locking device. Trolley catchers do not have these elements and purposes, and they function in a different manner because they respond to the force of a spring on a pole, not to the inertial force of a body.

Anticipation is impossible in accordance with the above authorities and many others.

II.

The Decision Conflicts With a Long Line of Authorities Because It Finds Two Arts Analogous Even Though the Arts Are in Completely Different Fields and for Completely Different Purposes.

The decision states (p. 10) that the basic concept is a spring-wound reel having certain characteristics, and that the trolley catcher reels are similar and hence are analogous art.

This takes into consideration only a portion of the inventions, rather than the subject matter as a whole. 35 USC 103 requires otherwise.

The subject matter as a whole is "safety apparatus for preventing a seat occupant of a vehicle from being thrown off his seat" (e.g Pfankuch claim 7). The pertinent art is that which would have been considered by a person having ordinary skill in the field to which the claims are directed. Inventors are not charged with knowledge of all arts. *In re Van Wanderham et al.* F. 2d, 154 USPQ 20 (CCPA June 15, 1967). *Application of Krogman* 223 F. 2d 497 (CCPA 1955).

Plaintiff contended throughout the Patent Office proceedings that the patents in other fields were non-analogous. This includes Sharpe, Scheuer, Caouette, Foss and Rutledge [Ex. 131, e.g. pp. 67, 68, 83]. The Patent Office Board of Appeals agreed, stating that those patents are for a different purpose [Ex. 131, pp. 90, 91].

Authorities which say that the subject matter as a whole must be considered rather than components are *Potts v. Creager* 155 U.S. 597 (1895), where a wood polishing machine was held nonanalogous to a machine to disintegrate and pulverize clay even though the same components were employed in each (the machines were

for different purposes and different industries); *Hobbs v. Beach* 180 U.S. 383 (1901) where an addressing machine was held nonanalogous to a machine for attaching stays to boxes; *A. J. Deer Co., v. U.S. Slicing Mach. Co.* 21 F. 2d 812 (7th Cir, 1927) where art of meat holders and the art of sawmill appliances were held nonanalogous; *In re Bennett* 65 F. 2d 144 (CCPA, 1933) where tin cans were held nonanalogous to sheet steel barrels; *Stearns v. Tinker & Rasor* 220 F. 2d 49 (9th Cir, 1955) where a different panel of this court held a snap switch for opening and closing an electrical circuit nonanalogous to a device for determining the condition of pipe coating even though the device employed the snap switch; *Kaakinen v. Peelers Company* 301 F. 2d 170 (9th Cir., 1952) where a different panel of this court held patents to shrimp peelers valid over cornhuskers, rock and gravel strainers, peanut stemmers and onionskinners; and *In re Van Wenderham et al, supra*, which reviews many authorities and held a heat exchanger nonanalogous to a cryogenic system even though the heat exchanger was employed as a component of the cryogenic system. The court emphasized that the subject matter as a whole must be considered, even though the whole employs a component from another art.

The decision here conflicts directly with the seven cases above.

III.

The Decision Conflicts With a Long Line of Authorities That Have Construed the Statutory Test for Obviousness Because It Employs a Hindsight Test, Rather Than Looking at What Was Known at the Time the Inventions Were Made.

The decision states (p. 12) that if appellee's engineers had considered trolley catchers, the inventions here would have been obvious.

The decision points out (p. 7) that trolley catchers are old and familiar devices. Appellee's engineers were aware of them. So were engineers of appellee's main competitor. Yet as a matter of fact the inventions were not obvious at the time to those leaders in the art.

Obviousness requires a factual inquiry. It is essentially a question of fact and subject to the clearly erroneous rule. *Graham v. John Deere Co.* 383 U.S. 1 (1966). *Skinner Co. v. Continental Industries* 346 F. 2d 170 (10th Cir, 1965). *American Technical Machine Corp. v. Caparotta* 339 F. 2d 557 (2nd Cir, 1964).

At the time of the inventions in suit, it is undisputed that all of those working in the art were thinking in terms of devices which respond to abnormal movement of the vehicle itself. Sensing inertial movement of a seat occupant was new. The Air Force doubted that it would work because it was radical departure.

With the advantage of hindsight, the Court has broader vision than those skilled in the art had in 1953. This is condemned by a long line of cases. *Graham v. John Deere, supra*. *In re Van Wanderham, supra*. *Application of Hofstetter* 362 F. 2d 293 (CCPA, 1966).

The above authorities require an objective test based upon the factual situation in 1953, not the subjective test today which was employed in the decision.

Respectfully submitted,

C. RUSSELL HALE,

D. BRUCE PROUT,

Attorneys for Appellee.

Certificate of Counsel

I, D. Bruce Prout, one of the attorneys for the appellee, certify that in my judgment this petition is well founded and it is not interposed for delay.

D. BRUCE PROUT

